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EXAMINER
LE, KHANH H

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	**Application No.** 09/625,832	**Applicant(s)** KHOO ET AL.
	Examiner Khanh H. Le	**Art Unit** 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *October 17 and 31, 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5,7-9,18,21-28 and 30-36* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5,7-9,18,21-28 and 30-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

Final Action

1.   This Office Action is in response to Papers #14 and #16, dated October 17 and 31, 2003.

Previous claim status:

Claims 1-2, 4-10, 18-30 were pending.   Claims 1,7, 8,9,10, 18, 19, 23 are independent.
 1-2, 4-10, 18-21, 23-27, 29-30 were examined.

Claims 22 and 28 were subject to a restriction requirement.

Present claim status:

Cancelled claims: 3-4, 6, 10, 11-17, 19-20, 29.

Amendments of claims 1-2, 5, 7, 8-9, 18, 22, 21, 23, 24, 28 and new claims 31-36 have been entered.

The restriction requirement of claims 22 and 28 is withdrawn per their amendments.

Claims 1-2, 5, 7, 8-9, 18, 21,22-28, 30-36 are now examined.

Interview of October 21, 2003:

 Present for the USPTO were Examiner Khanh H. Le, Primary Examiner James Myhre, (not Mr. Eric Stamber) ; for Applicants, Steven Moore, Esquire, Mr. Tray Ratcliff, a co-inventor. A software demonstration of the invention was made, some possible claim amendments were discussed , no agreement was reached.   Please note that no agreement was reached that Dedrick , US 5724521 does not teach a television broadcast/program, contrary to arguments at page 17 last 7th line.

Remarks:

Due to the claim amendments the previous rejections under 35 USC § 103 are withdrawn, others have been substituted.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Previous rejection of Claim 6 :mooted by cancellation.

Previous rejection of Claim 5 is withdrawn.

3.   **Claims 5, 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

It is not clear what " accessing an index" means. Applicants explains at page 15 that "index values" associated with each constraint are involved. If that is the case the claim should state "index values".   Absent a specific definition of "index", (page 20 lines 10-11 is not sufficient for such definition), "accessing an index" suggests only accessing a database of constraints whereby the constraints may be defined and not the idea of another value (Applicant's "index") associated with each constraint such that the index value would measure "the relative importance of the individual .. to the broadcaster", as argued.

Claim Rejections - 35 USC § 101

4.   Rejection of claims 1-2, 4-10, 18-20, 23, 26 under this section is withdrawn due to the amendments.

(b) the invention was patented or described in a printed publication in this or a foreign

country or in public use or on sale in this country, more than one year prior to the date of

application for patent in the United States.

5.   Claims 1-2, 7, 8, 9, 18, 23-25 28, 30-36   are rejected under 35 U.S.C. 102(b)
as being anticipated by Dedrick , US 5,724,521 A.

As to claims 1, 7, 8, 9, 18, 23 Dedrick discloses

A method, system and computer medium , over a data network, for an advertiser to fill an
advertisement in an advertisement spot which is to be directed to a plurality of target users
said method comprising:

receiving from said advertiser over said data network input in respect of a plurality of
predetermined profile constraints, said input pertaining to the desirability in regard
to each predetermined profile constraint to said advertiser of reaching target users possessing
such predetermined profile constraints

(see at least

Col 4 l. 59+ -col 5 l. 5

The advertiser 18 is also provided with software tools to generate a

"consumer scale " for each individual advertisement. **The consumer scale**

represents the value of the advertisement to the advertiser in terms of the

consumer characteristics of the end users which will consume the advertisement.

In one embodiment, the consumer scale provides a range of particular numbers of

consumer variables which must be satisfied by particular numbers of end users

served by a metering server 14 in order for the advertiser 18 to pay a

particular price . The advertiser 18 then transfers this consumer scale along

with the advertisement to the yellow page servers 22, where it is subsequently

made available to the end users of the metering servers 14.

*Thus, the consumer scale provides a mechanism by which a metering server 14
can determine how valuable the end users coupled to that server 14 are to the
advertiser 18. The advertiser 18 indicates how much it is willing to pay for
access to those end users, based on the consumer characteristics of those end
users.;*

col. 5 lines 21-29, "*...The consumer scale for a particular advertisement is dependent on the
consumer variables the advertiser 18 selects to associate with the
advertisement. In one embodiment, the advertiser 18 is provided with a GUI
which presents a set of consumer variables from which the advertiser 18 can
select. The advertiser 18 is also able to select certain consumer
characteristics which must be met in order for the advertiser 18 to agree to
pay a specified fee for delivery of the advertisement to the consumers.*

*Thus, the present invention allows individual advertisers to pay for access
to individual **consumers based on how desirable it is to the advertiser to
access those consumers**. The fee for access to consumers is based on the value
the advertiser places on different consumer characteristics which apply to each
individual electronic advertisement. Thus, the advertiser pays more for access
to consumers it finds highly desirable, and pays less for those consumers it is
less interested in.);;*

searching an individual inventory containing profile information related to a plurality of
individuals to determine a plurality of target users having a profile encompassing one or more of
said desired profile constraints

see at least " *At the metering*

servers, a determination is made as to where the characteristics of the end

users served by each of the metering servers fall on the consumer <u>*scale*</u> *. The*

higher the characteristics of the end users served by a particular metering

server fall, the higher the <u>*fee charged*</u> *to the advertiser;*

" *...Each metering server 14 also contains a consumer* <u>*scale*</u> *matching process 39.*

When the metering server 14 receives a unit of electronic information which

includes an electronic advertisement identifier (such as a title) and consumer

<u>*scale*</u> *from a yellow page server 22, the consumer* <u>*scale*</u> *is transferred to the*

consumer <u>*scale*</u> *matching process 39. The consumer* <u>*scale*</u> *matching process 39*

then compares the consumer <u>*scale*</u> **to the aggregate user profile data stored in**

the user profile database 30. The <u>*fee*</u> *that the metering server 14* <u>*charges*</u> *the*

advertiser 18 is dependent on **how well the consumer** <u>*scale*</u> **matches aggregate**

user profile data. *For example, the aggregate user profile data for the end*

users served by a particular metering server 14 falls at a particular point

along the consumer <u>*scale*</u> *. This particular metering server 14 then* <u>*charges*</u> *the*

advertiser 18 the <u>*fee*</u> *indicated by this particular point for access to the end*

users of the metering server 14...".)

The above excerpts imply that a database of users' profiles has to be looked at, and searched, in order to find which users match the constraints specified in order to match the consumer scale and thereby calculate the fee . Also see col. 12 lines 59-65; col 14 l. 8-12; specific users are targeted.)

       determining the cost to said advertiser for accepting said advertisement in said

       advertising spot ,and delivering the same to said plurality of target users, based on the

       degree of correspondence for each target user between the target user's profile and the

       <u>Advertiser's desire for transmission of the ad</u> with respect to each of said predetermined

profile constraints (absent specific definition of the term " Advertiser's desire", the constraint itself is interpreted as "the Advertiser's desire for transmission of the ad" based on that constraint) .

(see excerpts above; also, e.g., Dedrich at col 5 l. 30+ : e.g. in the calculation of the highest fee based on 60% of constraints met by at least 75% of users: in order to determine that 75% of the consumers match a certain constraint A, each of the consumer profiles has to be looked at to see if each consumer matches constraint A ; then each constraint A to Z has to be looked at for all the constraints to determine in the end whether 60% of the constraints are satisfied by at least 75% of the users. Thus Dedrich at col 5 l. 30-45 discloses that each target user is matched to the constraint . Thus Dedrich also teaches the degree of match, per user, based on each constraint, determines the cost of the ad.

transmitting to the advertiser the price for the advertiser's acceptance
(transmitting an order for the advertising spot to the broadcaster), rejection, or counteroffer
(see at least, "...(e) charging a fee to the advertiser based on the comparing..." .

In one embodiment, an indication is returned from each metering server 14 to
the advertiser 18 indicating where the metering server 14 falls on the consumer
scale. The advertiser 18 is then able to modify the consumer scale or any
other information relating to the advertisement, including the advertisement
itself, and resend the advertisement to the metering servers 14 via the yellow page servers 22 to
attempt a better match of end users to the consumer scale. (counteroffer)

Claim 2.   (Once Amended) The method of claim 1, wherein the said one or more predetermined constraints are demographic information including at least one of gender, income, hobby, and age (col 3 l. 35-38, age).

As to claim 24 (dep. on claim 1) Dedrick further discloses the step of transmitting the advertisement within the advertising spot to the one or more target users during transmission of the motion picture (col. 4 l. 36-45; col 13 lines 9-12: video, animation include motion picture).

As to claims 25, 28, 30 Dedrick discloses providing over the network demographics information characterizing the said one or more target users identified based on said one or more predetermined constraints. (col. 12 l. 55-65).

As to claims 31 -36, the ad spot being in a TV broadcast program is disclosed by Dedrich (col. 4 lines 36-35, col 13 lines 9-12).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   **Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick.**

Claim 27. wherein said determining the price takes into account a relationship between a supply and a demand for said plurality of individuals in said individual inventory.

As explained above in order to match the Dedrick consumer scale all users served by the meter have to be looked at and evaluated therefore the supply of the individuals in the individual inventory goes into determining the price. The demand for the users as defined by the advertiser constraints also goes into determining the price. Therefore it would have been obvious to one skilled in the art at the time the invention was made to deduce from these Dedrick's teachings that determining the price takes into account a relationship between a supply and a demand for said plurality of individuals in said individual inventory.

8.   **Claims 5, 22, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick in view of Herz et al, US 6571279 B1.**

As to claims 5 , 22 (dependent on claim 18), 26 (dependent on claim 1; claim 26 is broader than claim 5) ,

Absent a specific definition for the term "index" , "index" is interpreted as a catalog or a database. Thus "accessing an index of each of said predetermined constraints associated with each said plurality of target users" is interpreted as, for each constraint, accessing it, for each user, from an database (index).

Thus as to claims 5, 22 (dependent on claim 18), 26 (dependent on claim 1; claim 26 is broader than claim 5), Dedrick discloses the method of claim 1,and further discloses wherein said step of determining comprises:

accessing an index (database) of each of said predetermined constraints associated with each said plurality of target users (implied in order to calculate and match to the consumer scale as explained in claim 1)

specifying by the advertiser a coefficient of each of said predetermined constraints (Dedrick teaches the use of coefficients (different weights) on the different specified consumer variables,

col. 6 1. 12-32, as a another method of valuating the end users with a different matching scale) .
Further, each Dedrich consumer is to be evaluated per these constraints therefore these are
associated with each of said plurality of target users.

determining a demand (desirability) for each of said target users based on said index (of
constraints) and such coefficients: As explained above, the advertisers-specified constraints of
Dedrich are interpreted as determining a demand (desirability) of the users for the advertisers and
they are associated with each user. Further, the coefficients in Dedrich provide an alternate way
of evaluating such demand (desirability) therefore the Dedrich's demand (desirability) for each
of said target users is based on said index (of constraints) and such coefficients

Dedrich does not disclose the rest of claim 5 but Herz discloses, at col. 5 1. 15-35,

calculating an individual price for delivering the advertisement to each of said plurality of target
users based on the demand for that particular target user
for each targeted user, the individual prices to deliver the ad to such individual target user $P(x)$
which is $=P(D(1))$ (col. 5 1. 23-26);

Herz also discloses computing the price for delivering said advertisement to said plurality of
target users based on the calculated individual prices
(Herz teaches calculating the price of an ad delivered to a number of target users (P (1) as a
function of P $((1)= \max (1=1$ to n$)$ $P(D(1))$ of the individual prices to deliver to each target user
$(P(x))$ (col. 5 1. 26-30).

Note: Herz also discloses determining a demand for each of said target users based on said index
(of constraints):
(Herz teaches each target user has a demand (desirability) estimate $D(1)= x$ based on a number
of constraints (e.g. age) (col. 5 1. 15-35)

(and because H. teaches each target user 's demand (desirability) estimate D(l)= x, is based on a number of constraints (e.g. age),

H. necessarily and implicitly teaches that each constraint is accessed, for each user, from an index (database) so that each target user 's demand (desirability) estimate D(l)= x can be calculated.)

Thus H. discloses determining a demand for each of said target users based on said index (of constraints) .

It would have been obvious to one skilled in the art at the time the invention was made to add the teachings of Herz to those of Dedrich because both are in the advertising arts, using profile databases (Herz col. 4 l. 36-47) , both involve the use of advertiser-provided criteria for customization of ads and Herz would add to Dedrich another advantageous way of computing an advertising price based on all the target users.

Conclusion

9.   Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.
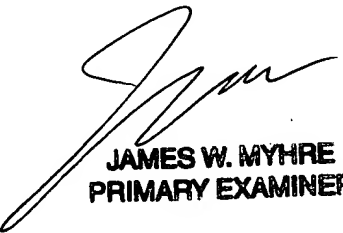
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

Jan 12, 2004

KHL

KHL

JAMES W. MYHRE
PRIMARY EXAMINER